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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/920,426	Applicant(s) CLARKE ET AL.	
	Examiner Arrienne M. Lezak	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,13-15,17,18,23-26 and 28-34 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,13-15,17,18,23-26 and 28-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Examiner notes that Claims 32-34 have been added, Claims 1, 14, 17, 24, 25, 26 & 31 have been amended and no claims have been cancelled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 8 June 2005 as reiterated herein below.
2. Additionally, Examiner telephoned Applicant's Attorney, Jordan Becker on 1 November 2005 in order to clarify claim language and discuss possible patentable subject matter. Applicant's attorney repeatedly inquired into a legal basis for Examiner's request and Examiner repeatedly responded that her intent was to advance prosecution in the matter. Applicant's attorney told examiner that technical questions would have to be referred to an associate and Examiner explained that she preferred speaking with someone with authority to amend the claim language, suggesting a conference with Mr. Becker and his associate to better clarify the claim language. Mr. Becker was unable to accommodate Examiner's request.
3. Examiner additionally requested if Applicant would be amenable to the incorporation of the claim language from claims 32 & 33 into the independent claims and Mr. Becker indicated that he would not be willing to further narrow the claim language without evidence of prior art. Examiner asked Applicant's attorney if he would like to address the matter with his client and Mr. Becker indicated that he would noting that he believed the Examiner to require an immediate response, to which Examiner noted that she would be happy to give his client a chance to make a decision in this

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matter. Mr. Becker left a message for Examiner later that evening noting his client's willingness to add the claim limitations from claim 32 only into the independent claims. Examiner finds this response to be insufficient for purposes of rendering the claims patentable as they do not enumerate the inclusion of claim 33 and they do not further clarify and enumerate how the back-off time is computed as required by Examiner for determination of patentability over the prior art and in light of an additional search. Additionally, should Applicant decide to clarify and amend the claim language, Examiner notes that further search and consideration would be required for purposes of a patentability determination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-7, 13-15, 17, 18, 23-26 & 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent US 6,650,619 B1 to Schuster in view of US Patent US 6,446,108 B1 to Rosenberg in view of US Patent US 6,661,773 B1 to Pelissier.

6. Regarding Claims 1, 14, 15 & 24-26, Schuster discloses, a method, system and computer-readable medium for operating an intermediary network/Internet, (per pending Claim 15), node, the method comprising:

- a processor, (Col. 6, lines 25-39 & Col. 7, lines 37-62);
- a data communication device coupled to the processor to communicate data between the processing system and a plurality of other nodes on the network, (Col. 5, lines 45-48; Col. 6, lines 25-39; & Col. 7, lines 37-62);
- a storage facility coupled to the processor and storing instructions, for execution by the processor, (Col. 6, lines 25-39 & Col. 7, lines 37-62), which configure the processing system to execute a process to proxy requests and responses on behalf of the plurality of other nodes on the network, (Col. 10, lines 54-67; Col. 11, lines 1-12; & Fig. 3), the process including;
- using the intermediary network node to proxy requests and responses to requests between a plurality of clients and a plurality of servers, (Col. 8, lines 23-51; Col. 10, lines 54-67; Col. 11, lines 1-12; & Fig. 3), wherein at least one of the clients is a mobile client operating on a wireless network, (Col. 5, lines 34-44), and at least one of the servers operates on a landline network, (Col. 6, lines 25-27), the intermediary network node coupled between the wireless network and the landline network, (Col. 6, lines 25-39);

- using the intermediary network node to convert messages between a wireless protocol used by the wireless network and a second protocol used by the landline network, (Col. 6, lines 25-39);
- using the intermediary network node to detect network congestion on at least the landline network, (Col. 4, lines 60-67; Col. 5, lines 1-4; Col. 13, lines 4-67; & Col. 14, lines 1-47); and
- determining, in the intermediary network node, when a request received by the intermediary network node from one of the clients destined for one of the servers should not be forwarded by the intermediary network node, based on network congestion detected by the intermediary network node, (Col. 14, lines 41-58).

7. Though Schuster discloses a signaling/message/flow control system, Schuster does not specifically teach the use of specific-type messages, namely a message flow control algorithm. Rosenberg discloses use of a message flow control algorithm, (Rosenberg - Col. 3, lines 34-67 & Col. 4, lines 1-45). It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the Rosenberg flow control algorithm in to the Schuster system, as once the signaling server learns of the state of congestion, it may instruct the registered gateways to reduce the number of signaling messages that they send, (Schuster - Col. 4, lines 26-59), which instruction would obviously include some sort of the "back-off" algorithm, especially in light of the Schuster "congestion mode" or "emergency mode" wherein a gateway messaging is limited, or obviously eliminated in severe congestion situations.

8. Schuster further discloses using the intermediary node to provide a (back-off) message indicating congestion on the network to a downstream node (client) on the network, when congestion on the network is detected, (Schuster - Col. 12, lines 51-67 & Col. 13, lines 1-37), wherein the message is obviously sent in response to the intermediary node receiving a request from the downstream device destined for an upstream node on the network, (Examiner notes that a state of congestion could obviously be caused by excessive bi-directional message signaling from any location on the network). Moreover, Rosenberg discloses wherein the message specifies a back-off criterion (algorithm) for use by any other node on the network, obviously including any downstream node, wherein the back-off criterion (time-period) is computed in the intermediary node, (Rosenberg – Col. 3, lines 34-67 & Col. 4, lines 1-45). Examiner notes that it would have been obvious to utilize the gatekeeper/gateway for purposes of algorithm application in light of its function as “brain” of the signaling system, (Schuster - Col. 6, lines 23-51).

9. As noted herein, the Schuster clearly provides for a “congestion mode” wherein a state of congestion is detected, and wherein detecting a state of congestion obviously includes node response failure of any type, as within a state of congestion, it is common for data to be disregarded until the congestion condition eases. In the event that data is disregarded and thus does not exist, a response to said data would obviously also not exist. That noted, Examiner additionally provides the Pelissier reference which further teaches detection of a route problem wherein any given node may automatically enter a cell tagging mode as part of an internal re-route algorithm, which cell tagging data is

found in the header of the cell, and which cell tagging data includes information pertaining to time, (Col. 4, lines 4-67 & Col. 5, lines 1-42). The motivation to combine the teachings of Schuster and Pelissier is found within Pelissier which notes a need to simply and efficiently detect and discard redundant or duplicate stale cells from the network, (Col. 4, lines 64-66), which process would serve to alleviate the congestion noted within Schuster. Thus, Claims 1, 14, 15 & 24-26 are found to be unpatentable in light of the combined teachings of Schuster, Rosenberg and Pelissier.

10. Regarding Claims 3-6, 17 & 27-30, the combined teachings of Schuster, Rosenberg and Pelissier is relied upon for those teachings noted herein. Schuster further discloses using the intermediary node to detect congestion on the network, (per pending Claim 3), (Schuster - Col.13, lines 10-37), wherein detecting congestion on the network would obviously be based on a back-off message, (control signal), received by the intermediary node from an upstream node on the network, (per pending Claims 4 & 17), (Schuster - Col. 13, lines 31-37). Moreover, Rosenberg discloses wherein the back-off message obviously specifies one or more back-off criteria, (per pending Claim 5), and the necessary metadata indicating applicability of the back-off message, (per pending Claim 6), (Rosenberg – Col. 3, lines 34-67 & Col. 4, lines 1-45). Thus, Claims 3-6, 17 & 27-30 are found to be unpatentable in light of the combined teachings of Schuster, Rosenberg and Pelissier.

11. Regarding Claims 7, 18 & 31, the combined teachings of Schuster, Rosenberg and Pelissier is relied upon for those teachings noted herein. Schuster further discloses detecting congestion on the network, wherein said detection could obviously be based

on a failure by an upstream node on the network to respond to a request forwarded by the intermediary node, (Schuster - Col. 12, lines 51-67 & Col. 13, lines 1-37). Thus, Claims 7, 18 & 31 are found to be unpatentable in light of the combined teachings of Schuster, Rosenberg and Pelissier.

12. Regarding Claims 13 & 23, the combined teachings of Schuster, Rosenberg and Pelissier is relied upon for those teachings noted herein. Rosenberg further discloses using a back-off strategy to determine when a request received by the intermediary node should not be forwarded, and wherein the method further comprises adapting the back-off strategy dynamically based on operation of the network, (Rosenberg – Col. 3, lines 34-67 & Col. 4, lines 1-45). Thus, Claims 13 & 23 are found to be unpatentable in light of the combined teachings of Schuster, Rosenberg and Pelissier.

13. Regarding Claims 32-34, the combined teachings of Schuster, Rosenberg and Pelissier is relied upon for those teachings noted herein. Pelissier further discloses wherein the back-off time period is included in a header of the outgoing message, (per pending Claim 32), (Pelissier – Col. 5, lines 2-42). As Schuster discloses a method of Internet telephony, said method obviously includes the use of HTTP, (per pending Claim 33), as HTTP is the well-known and standard way of transferring information across the Internet, (Please see Newton's Telecom Dictionary noted herein below). Moreover, as Schuster discloses a method of Internet telephony, the intermediary node could obviously comprise a telephone switch, (per pending Claim 34). Thus, Claims 32-34 are found to be unpatentable in light of the combined teachings of Schuster, Rosenberg and Pelissier.

Response to Arguments

14. Applicant's arguments filed 16 September 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

15. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes that Rosenberg clearly teaches the limitation of "using a flow control algorithm" and Schuster clearly teaches the limitation of "an intermediary node", as noted herein above.

16. In response to applicant's argument that Schuster and Rosenberg in combination would not have been obvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant Argues that Schuster and Rosenberg in combination would not have been obvious because Schuster "teaches away" from such

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combination. Applicant relies on portions of Schuster, which teach alternate routing means in very specific situations; however, Examiner notes that such alternatives are optional, (as noted by the wording “may be programmed” and “may instruct”).

Regardless of what may happen in certain situation, Schuster clearly teaches the H.323 protocol, which protocol clearly includes a “gatekeeper-routed model”, (Col. 10, lines 54-67 & Col. 11, lines 1-12). Moreover, Schuster clearly teaches a preferred embodiment wherein the signaling subsystem (gatekeeper) is modified, (i.e.: per a flow control algorithm like that taught by Rosenberg), to respond to a state of congestion by switching mode in which the gateway at least temporarily, (i.e.: for some time period), does not transmit, (i.e.: backs-off), (or transmits less often) a particular type or types of signaling request message, (Col. 14, lines 18-47). Examiner additionally notes that the switching to “direct-routing” is optional as taught by Schuster and does not eradicate the gatekeeper option.

17. In response to Applicant’s argument that the combined references do not teach wherein the flow control algorithm is a function of at least one of: a received back-off message or response failure, Examiner respectfully disagrees noting the newly cited art and arguments noted herein above. Additionally, the new claims are also found to be unpatentable as noted herein above. Thus, Examiner has addressed Applicant’s Amendment, and has further rejected all claims, as noted herein above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Please see Newton's Telecom Dictionary, 18th Ed., Harry Newton, CMP Books, 2002, p.358.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
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